

REMARKS

Claims 1, 4-28, and 31-58 are pending in the application.

Claims 5-28, 31-33, 37-49 and 53 have been withdrawn from further consideration as being drawn to unelected subject matter.

Claims 1, 36 and 54 have been amended.

Claim 58 has been newly added.

Claims 2, 3, 29 and 30 have been cancelled without prejudice or disclaimer to the subject matter contained therein.

Applicants specifically retain the right to pursue the subject matter contained in any of the amended or cancelled claims in this or an appropriate divisional, continuation or continuation-in-part application(s).

The amendments and new claims do not include any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendments is respectfully requested.

I. Response to Advisory Action dated March 1, 2010.

In the Advisory Action, the Examiner indicates that the rejection of claims 1-4, 29, 30, 34-36 and 50-52 as being anticipated by Schlegel et al. has been maintained because, allegedly, the claims do not distinguish a specific patient population or sample population.

Applicants respectfully traverse this rejection.

Applicants note that each of the presently pending independent claims has been amended to recite that the sample to be investigated is obtained from a patient with a prostate and that the methods or kits require determining whether the patient has no prostate cancer, prostate cancer subtype a, prostate cancer subtype b or prostate cancer subtype. As dependent claims are construed to include all of the elements of the claims from which they depend from, Applicants respectfully submit that the pending methods and kits all actively recite that a sample from a patient having a prostate is required.

The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. The identical invention must be

shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Schlegel et al. do not anticipate the presently claimed subject matter because Schlegel et al. do not teach every element of the claimed subject matter. As discussed in the Amendment and Response filed on January 21, 2010, Schlegel merely describe the identification of differentially regulated RNA molecules in prostate tissue of prostate cancer patients versus healthy prostate tissue. *See* Schlegel et al., page 46, paragraphs [0309] and [0310].

For the sake of compact prosecution, the remarks made in the January 21, 2010 Response are incorporated herein by reference. As discussed, , *Schlegel et al. do not teach or suggest determining whether the patient has no prostate cancer, prostate cancer subtype a, prostate cancer subtype b or prostate cancer subtype c based on the abundance of annexin A3 in the sample compared to the abundance of annexin A3 in the control sample.* Therefore, the presently claimed subject matter is not anticipated by Schlegel et al.

Therefore, Applicants submit that Schlegel et al. do not anticipate, either expressly or inherently, the presently claimed subject matter. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

CONCLUSION

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejection and to allow all of the claims pending in this application.

Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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